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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,448	11/21/2001	Adrian Velthuis	08011.3012-00	1416

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/989,448

Applicant(s)

VELTHUIS ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 9/7/06.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 12 is a system (apparatus) claim, yet it provides limitations that appear more as method claims than structural (programmed capabilities). The server should be claimed as programmed to transmit, programmed to receive. The ad server should be claimed as programmed to receive and transmit. Similar changes should be made to claim 13.
- Claim 13 is confusing as it appears that the ad server should serve/transmit the banner, even if the web server delivers to the user the HTML address for the ad located at the ad server.
- Claim 14, it is unclear what structure (programmed capability) is provided that enables the suggested redemption abilities.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3, 7-9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view Sim (KR2000030358A).** Sim

(KR2000030358A) is a document that was published June 5, 2000. The WO 01/63507 A1 document has been included merely as an English-language equivalent of Sim (KR2000030358A) and will be used to reference portions of Sim's disclosure which support the examiner's conclusions.

Regarding claims 1, 7-9, 12, 14, Mankoff et al teaches the concept of a user browsing webpages on the Internet and clicking a banner advertisement to request an electronic coupon be delivered (from a coupon server) to his computer. Mankoff et al teaches that the coupon can be redeemed at a retailer by synchronizing (connecting) the computer to the retailer computer and transferring the coupon to the retailer. Mankoff et al teaches delivery of electronic coupons to user devices such as PDA's, smart watches Internet appliances and other devices [col 3 lines 35-39]. Mankoff et al does not teach delivery to wireless phones. Sim (KR2000030358A) teaches delivery of electronic coupons to wireless phone users [pg 3] and it would have been obvious to one of ordinary skill at the time of the invention to have delivered the coupons of Mankoff et al to user's phones as an alternative portable coupon device. Sim

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(KR2000030358A) teaches that a database is provided on coupon server 6 which stores users' phone numbers so that coupons can be delivered to a particular identified user phone. It would have been obvious to one of ordinary skill at the time of the invention to have prompted a PC-banner-browsing user for his cell phone number so that the user could register to have his wireless device identifying phone number (or other wireless identifier) receive and store a delivered electronic coupon. In this manner, a user browsing at home on a non-portable PC could request the coupon be sent to his cell phone so that he could redeem the coupon in the store in a portable manner as suggested. Sim (KR2000030358A) teaches the ability to display the coupons [coupons have text and/or pictures - page 4: lines 18-22; phones have a display screen – FIG 1] and the concept to present the coupons to store employees for redemption [4:32-35]. The coupons of Mankoff et al and Sim (KR2000030358A) are both taken to be a purchasing incentives.

Regarding claims 3, 11, Official Notice is taken that display capabilities of cell phones vary from model to model and that some provide a text-only display while others enable monochrome images and others enable color images. It would have been obvious to one of ordinary skill at the time of the invention to have displayed a subset of coupon data (text and/or black and white images) on phones with less capable displays.

As best understood regarding claim 13, Mankoff teaches that the banner is an image link embedded in a webpage [1:44-48] and that links may be provided between sites [2:8-15]. It is well known that banners can be served from an ad server while the page that the banners are embedded into can come from a different content server. It

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would have been obvious to one of ordinary skill at the time of the invention to have done so with the banners of Mankoff in order to separate the content source(s) from the ad source(s).

4. Claims 2, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view of Sim (KR2000030358A) and Golden et al (US57616448).

Regarding claims 2, 10, Mankoff et al does not teach limiting the number of coupons to be downloaded to the user device. Golden et al also teaches downloading electronic coupons to a user computer. Golden et al provides a feature whereby the user may download only a certain number of coupons [col 4 lines 2-8]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled such a provision of a predetermined maximum number of coupons that can be downloaded to the user's device. Such a feature would help prevent coupon fraud, for example.

Response to Arguments

Applicant argues that the content from Mankoff and Sim both are directly downloaded to the client. However as set forth in the action, it would have been obvious to one of ordinary skill at the time of the invention to have clicked a banner on a PC from a user's home and requested registration of his cell number so that the coupon can be delivered to his portable cell for redemption in the store as described.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

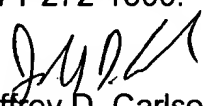
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc